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FOR APPLICATION NO. 10/655,935

26 10 46

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Serial No. 10/655,935

Atty. Docket No. TOM2809US02

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In re Application of :
 Stefan Gafner et al. : Group Art Unit: 1654
 Serial No.: 10/655,935 : Examiner: Michelle C. Flood
 Filed: September 5, 2003 : Response to Paper No.
 For EXTRACT OF MAD-DOG SKULLCAP

RESPONSE TO RESTRICTION REQUIREMENT UNDER 35 U.S.C. 121

Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

SIR:

This is in response to the Office Action dated April 26, 2004.

Claims 1-19 remain pending in the present application.

Restriction has been required between (I) claims 1 and 2, drawn to an extract of *Scutellaria laterifolia* L., (II) claims 3-7, drawn to a process for obtaining an extract of *Scutellaria laterifolia* L., (III) claims 8-11, drawn to a composition comprising an extract of *Scutellaria laterifolia* L. combined with a stabilizing agent, and (IV) claims 12-19, drawn to a process for obtaining an extract of *Scutellaria laterifolia* L. using a stabilizing agent. This restriction requirement is respectfully traversed.

CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8 (e))

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Date: 5/26/04

Patrick R. Scanlon
 Signature
Patrick R. Scanlon

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Serial No. 10/655,935

Atty. Docket No. TOM2809US02

The Examiner states that inventions I and II are related as process of making and product made and that the process as claimed can be used to make another and materially different product. By way of example, the Examiner refers to the process disclosed in U.S. Patent No. 6,608,102 to Howell et al. However, while the process disclosed in Howell et al does arguably produce a product that is materially different from the product of claims 1 and 2, the process used by Howell et al is not the process as claimed in the present application. The process as claimed in claims 3-7 uses *Scutellaria laterifolia* L. plant material. Howell et al uses dried leaves or fruit of *Vaccinium macrocarpon* and does not use *Scutellaria laterifolia* L. plant material. Accordingly, there is no showing that the process as claimed could make another and materially different product.

For similar reasoning, applicant submits that U.S. Patent No. 2,774,714 to Hershberg et al does not show that the process as claimed in claims 12-19 could be used to make a product that is materially different than the product of claims 8-11.

The Examiner has provided no showing of how invention I is distinct from inventions III and IV (and vice versa) or how invention II is distinct from inventions III and IV (and vice versa).

For the above reasons, reconsideration and withdrawal of the restriction requirement is respectfully requested.

Applicant provisionally elects invention I, claims 1 and 2 for further prosecution. The remaining claims will be retained pending resolution of the traversal and possible rejoinder.

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Serial No. 10/655,935

Atty. Docket No. TOM2809US02

An action on the merits is awaited.

Respectfully submitted,

5/26/04

Date

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